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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,387	04/18/2001	Paul Brand	P01.0064	5055
26574	7590	12/30/2003		
SCHIFF HARDIN & WAITE 6600 SEARS TOWER 233 S WACKER DR CHICAGO, IL 60606-6473			EXAMINER OROPEZA, FRANCES P	
			ART UNIT 3762	PAPER NUMBER 18

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/763,387

Applicant(s)

BRAND ET AL.

Examiner

Frances P. Oropeza

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/10/03 (Remarks).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. Claims 7-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Hawkins et al. (US 6029089).

Schiff discloses a metal sleeve (48), read as metallic tubular member, disposed in a housing (30), containing a plurality of interior components (figure 3) to make electrical contact with the plug (18) (figures 2, 3, and 7).

As related to claim 10, the screw pin assembly area (51) of the connector socket (33) is read as the lateral opening. The internal tip of the threaded bore (50) provides the contact surface for the cathode contact (27), read as the internal component providing a contact surface the electrical connection between the tip cathode (22) and the wire (44) connecting the lead to the circuitry in the casing (figures 2 and 3; col. 7 @ 10-14).

As related to claim 11, the connector socket (33), read as the plug (26), is constructed of insulating material (47) (figures 2 and 3).

As related to claims 16, the plug (35) is representative of the locking arrangement.

As discussed in the previous four paragraphs of this action, Schiff discloses the claimed invention except:

- the housing being metallic (claim 7),
- the tubes ends being bonded (claim 8) or welded (claim 9) to the housing,
- the plug being ceramic (claim 11), and

- the plug being mechanically attached (claim 11), soldered (claim 12) or bonded (claim 13).

As related to claims 7-9, Hawkins et al. teach implantable device component assembly using a metallic housing with the barrel welded or bonded to the housing for the purpose of securing the barrel assembly in the device. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used metallic housing and bonding or welding the barrel to the housing in the Schiff system in order to simplify the device housing by replacing the cast epoxy connector with a metallic housing and using a weld/ bond to provide firm attachment of the barrel so the device is simplified and hermetically sealed and protected from bodily fluids (figure 3; col. 2 @ 26-47; col. 5 @ 35-45).

As related to claim 11, Hawkins et al. teach inert materials of construction using ceramic for the purpose of providing system elements that will insulate system components and not conduct electricity. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used ceramic as the electrically inert material in the Schiff system in order to provide a material that enables effective electrical signals transfer. (figure 3; col. 2 @ 26-47; col. 5 @ 35-51).

As related to claims 11, 12 and 13, Hawkins et al. teach ceramic component mounting using mechanical attachment, soldering or bonding for the purpose of securing the ceramic component in position. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used mechanical attachment, soldering or bonding to secure the ceramic components in the Schiff system in order to provide securely connected components that

can be effectively hermetically sealed to protect the device from bodily fluids. (figure 3; col. 2 @ 26-47; col. 5 @ 35-51 ).

The Applicant's arguments filed 11/10/03 have been fully considered, but they are not convincing.

The Applicant argues the Examiner has incorporated the Hawkins et al. reference to teach welding the barrel/ tubular member to the housing. The Examiner disagrees. Hawkins et al. is incorporated in the rejection of record to teach use of a metallic housing, welding the tube ends to the housing, use of a ceramic insulting plug, and ceramic component attachment as noted in the previous paragraphs of section 1 of this action.

In response to the Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant argues Hawkins et al. do not disclose a continuous metal tube but rather a socket, hence the instant invention is not taught. The Examiner disagrees. As detailed in section 1 of this action, Schiff teaches a pacemaker with a metal sleeve (48), read as a metal tube. Hawkins et al. is incorporated in the rejection to teach use of a metallic housing, welding the tube ends to the housing, use of a ceramic insulting plug, and ceramic component attachment.

In response to the Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., insulation problems) are not recited in the rejected claim(s). Although the claims are interpreted in light of

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the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant appears to argue the female socket taught by Hawkins et al. could not be incorporated in the Schiff reference without encountering insulation difficulties. It is noted the instant invention is taught by the combination of the Schiff and Hawkins et al. references without incorporating the connector bore unit/ female socket taught by Hawkins et al.

2. Claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff (US 5383913) in view of Hawkins et al. (US 6029089) and further in view of Peers-Trevarton (US 4784141) for the reasons of record.

As discussed in paragraph 2 of this action, modified Schiff discloses the claimed invention except for an at least partially removable locking arrangement in the second tube end.

Peers-Trevarton teaches lead confinement using a lead locking mechanism (44) for the purpose of securing the lead in the cardiac pacer header. Several locking mechanism components, the screw (52) and cap (56), are removable. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a lead locking mechanism in the modified Schiff system in order to reduce the size of the cardiac pacer by reducing the thickness of the neck portion of the cardiac pacer to enable the smaller device to be implanted in the body relatively comfortably and inconspicuously (figures 7 and 10; col. 1 @ 31-36 and 60-64; col. 5 @ 19-37).

*Allowable Subject Matter*

3. Claims 14 and 15 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Statutory Basis*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

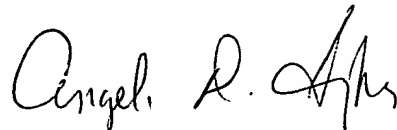
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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza  
Patent Examiner  
Art Unit 3762

*ffo*  
*12/22/03*



ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER